

ESTTA Tracking number: **ESTTA626955**Filing date: **09/14/2014**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	George A. Powell		
Entity	Individual	Citizenship	UNITED STATES
Address	920 Garden St. c/o Koenig & Associates Santa Barbara, CA 93101 UNITED STATES		

Attorney information	Kurt Koenig Koenig & Associates 920 Garden St. Santa Barbara, CA 93101 UNITED STATES Kurt@incip.com Phone:805-965-4400
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Registration Subject to Cancellation

Registration No	3683850	Registration date	09/15/2009
Registrant	Michael M. Woldman 6424 Weaver Road Rockford, IL 61114 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2008/05/01 First Use In Commerce: 2008/06/01 All goods and services in the class are cancelled, namely: Clothing, namely, shirts, t-shirts, tops, jerseys, vests, sweaters, caps, bandanas, shorts, sweat shirts, pants, belts, socks, swimwear, jackets, rainwear, footwear, hats, headbands, headwear, pajamas, sleepwear and undergarments
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Grounds for Cancellation


<i>Torres v. Cantine Torresella S.r.l. Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1091899	Application Date	09/01/1977
Registration Date	05/23/1978	Foreign Priority Date	NONE
Word Mark	BONES		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 1977/07/05 First Use In Commerce: 1977/07/05 WHEELS FOR SPORTING ARTICLES-NAMELY, WHEELS FOR SKATE-BOARDS

U.S. Registration No.	1501450	Application Date	12/23/1987
Registration Date	08/23/1988	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1977/07/00 First Use In Commerce: 1979/06/00 SPORTING GOODS, NAMELY SKATE BOARDS ANDPARTS THEREFOR; AND WHEELS FOR ROLLER SKATES		

U.S. Registration No.	1559066	Application Date	12/23/1987
Registration Date	10/03/1989	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1977/06/00 First Use In Commerce: 1977/06/00 PROMOTIONAL CLOTHING, NAMELY SWEATSHIRTS AND T-SHIRTS		

U.S. Registration No.	1695119	Application Date	05/07/1990
Registration Date	06/16/1992	Foreign Priority Date	NONE
Word Mark	BONES BRIGADE		

Design Mark	BONES BRIGADE
Description of Mark	NONE
Goods/Services	Class 200. First use: First Use: 1981/03/00 First Use In Commerce: 1981/03/00 indicating membership in an organization of skateboarding enthusiasts

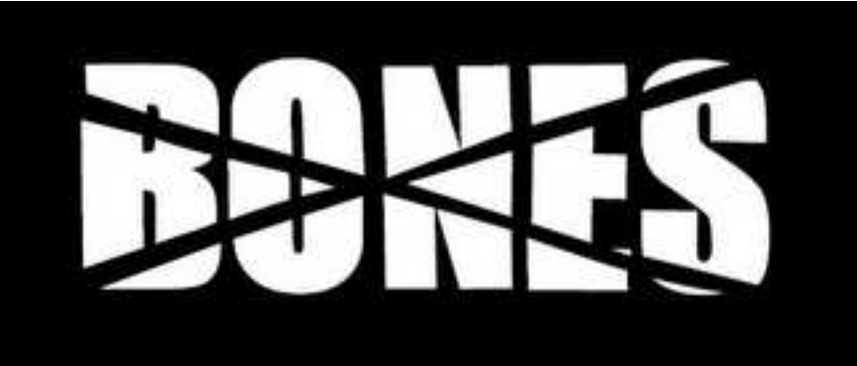
U.S. Registration No.	1705475	Application Date	05/07/1990
Registration Date	08/04/1992	Foreign Priority Date	NONE
Word Mark	BONES BRIGADE		
Design Mark	BONES BRIGADE		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1979/06/00 First Use In Commerce: 1979/06/00 entertainment services; namely, conducting professional skateboarding team competitions and exhibitions		

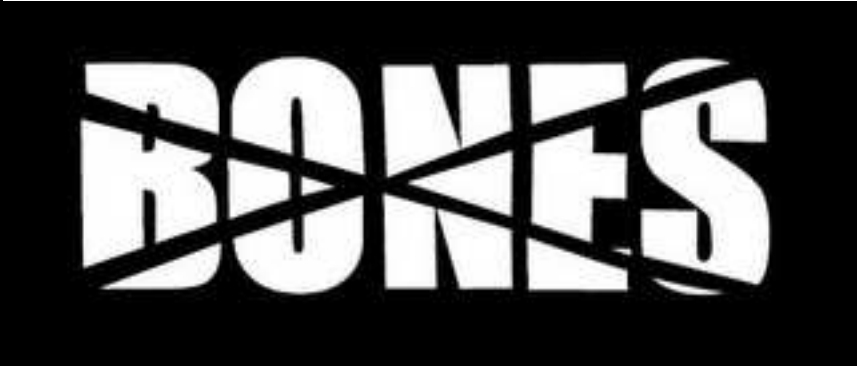
U.S. Registration No.	2553383	Application Date	08/23/1999
Registration Date	03/26/2002	Foreign Priority Date	NONE
Word Mark	HARDCORE BONES		

Design Mark	HARDCORE BONES
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 2000/07/12 First Use In Commerce: 2000/07/12 SPORTING GOODS, namely, [SKATEBOARDS AND PARTS THEREFOR,] SKATEBOARD [WHEELS, AND] WHEEL BUSHINGS

U.S. Registration No.	3061458	Application Date	11/16/2001
Registration Date	02/28/2006	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark	BONES		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1977/06/30 First Use In Commerce: 1977/06/30 Clothing, namely, hats, shirts, jackets, sweat shirts and belts		

U.S. Registration No.	3810594	Application Date	11/10/2009
Registration Date	06/29/2010	Foreign Priority Date	NONE
Word Mark	BONES		

Design Mark	
Description of Mark	The mark consists of The word "BONES" centered in a rectangular box with two lines in the shape of an "X" or cross through the letters.
Goods/Services	Class 028. First use: First Use: 2006/09/01 First Use In Commerce: 2006/09/01 Skateboard wheels, Skateboard bushings, Skateboard riser pads, Skateboard wax, Skateboard grip tapes, Skateboard hardware, namely, nuts and bolts for skateboards

U.S. Registration No.	3810792	Application Date	11/20/2009
Registration Date	06/29/2010	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark			
Description of Mark	The mark consists of the word "BONES" centered in a black rectangular box with two diagonal lines that form the shape of an x or a cross through the letters inthe word "BONES" .		
Goods/Services	Class 025. First use: First Use: 2006/09/01 First Use In Commerce: 2006/09/01 Baseball caps; Caps; Hats; Headgear, namely, baseball caps, beanies, and caps; Headwear; Shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleevedt-shirts; Short-sleeved shirts; Sweat shirts; T-shirts; Tops; Wearable garmentsand clothing, namely, shirts		

U.S. Registration No.	3584070	Application Date	08/15/2007
Registration Date	03/03/2009	Foreign Priority Date	NONE
Word Mark	ROLLER BONES		

Design Mark	ROLLER BONES
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 1981/07/31 First Use In Commerce: 1981/07/31 Roller Skate Wheels

U.S. Registration No.	3633328	Application Date	06/06/2006
Registration Date	06/02/2009	Foreign Priority Date	NONE
Word Mark	RAT BONES		
Design Mark	RAT BONES		
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1983/12/28 First Use In Commerce: 1983/12/28 Sporting goods, namely, skateboard wheels, skateboard wheel assemblies and parts and fittings for any thereof		

U.S. Registration No.	3735248	Application Date	04/15/2009
Registration Date	01/05/2010	Foreign Priority Date	NONE
Word Mark	BONES REDS		

Design Mark	BONES REDS
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 1999/09/02 First Use In Commerce: 1999/09/02 Ball bearings for skateboards

U.S. Registration No.	3905805	Application Date	06/06/2006
Registration Date	01/11/2011	Foreign Priority Date	NONE
Word Mark	RAT BONES		
Design Mark	RAT BONES		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2010/07/20 First Use In Commerce: 2010/07/20 Clothing, namely, activewear, sportswear, skatewear, and other clothing for sports, namely, T-shirts, shirts, tops, hats, headwear		

Attachments	73703301#TMSN.png(bytes) 73703239#TMSN.png(bytes) 74056716#TMSN.png(bytes) 74056717#TMSN.png(bytes) 75782886#TMSN.png(bytes) 76338768#TMSN.png(bytes) 77869282#TMSN.png(bytes) 77878031#TMSN.png(bytes) 77256251#TMSN.png(bytes) 78980980#TMSN.png(bytes) 77714670#TMSN.png(bytes) 78901655#TMSN.png(bytes) Petition for Cancellation Big Bonez.pdf(170246 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Kurt Koenig/
Name	Kurt Koenig
Date	09/14/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No. 3683850
For the mark: BIG BONEZ
Registration Date: September 15, 2009

GEORGE A. POWELL,)	
)	
)	
PETITIONER,)	CANCELLATION NO.: _____
)	
v.)	
)	
MICHAEL M. WOLDMAN,)	
)	
RESPONDENT.)	
)	

PETITION FOR CANCELLATION



In the matter of the Registration of MICHAEL M. WOLDMAN, an individual citizen of the United States having a address of 6424 Weaver Road, Rockford, IL 61114, (hereinafter “Respondent”), for registration of the trademark BIG BONEZ (“Respondent’s Mark”), as set forth in Registration No. 3683850, registered by the U.S. Patent and Trademark Office on September 15, 2009 (the “850 Registration”), George A. Powell, an individual citizen of the United States having an address of 30 South La Patera Lane, Santa Barbara, California 93117 (hereinafter “Petitioner”), believes he will be damaged by the use and continued registration of Respondent’s Mark and hereby petitions to cancel the same.

The grounds for cancellation are as follows:

1. Petitioner, through his related companies and licensees, for many years and long prior to any date of first use upon which Respondent can rely, has continuously used, licensed, manufactured, sold, distributed, and advertised in interstate commerce in conjunction with the mark BONES and marks incorporating the word BONES, for various goods and services,


including apparel, streetwear, boardwear, skateboards, action sports apparel, sporting goods, and related accessories, and retail store services.

2. Petitioner is the owner of common law rights and at least fifteen (15) valid and subsisting United States trademark registrations, covering a variety of goods and services, for the mark BONES, which is used alone and in combination with other words and/or designs (collectively “Petitioner’s Marks”) as shown in the following trademark registrations:

<u>MARK</u>	<u>CLASS</u>	<u>GOODS/SERVICES</u>	<u>REG. NO.</u>	<u>REG. DATE</u>
BONES	28	Wheels for sporting articles - namely, wheels for skateboards.	1091899	05/23/1978
	28	Sporting goods, namely skate boards and parts therefore; and wheels for roller skates.	1501450	08/23/1988
	25	Promotional clothing, namely sweatshirts and t-shirts.	1559066	10/03/1989
BONES BRIGADE	200	Indicating membership in an organization of skateboarding enthusiasts.	1695119	06/16/1992
BONES BRIGADE	41	Entertainment services; namely, conducting professional skateboarding team competitions and exhibitions.	1705475	08/04/1992
HARDCORE BONES	28	Sporting goods, namely skateboards and parts therefore, skateboard wheels, and wheel bushings.	2553383	03/23/2002
BONES	25	Clothing, namely, hats, shirts, jackets, sweat shirts and belts	3061458	2/28/2006
BONES & Design	28	Skateboard wheels, Skateboard bushings, Skateboard riser pads, Skateboard wax, Skateboard grip tapes, Skateboard hardware,	3810594	6/29/2010



namely, nuts and bolts
for skateboards

BONES & Design	25	Baseball caps; Caps; Hats; Headgear, namely, baseball caps, beanies, and caps; Headwear; Shirts; Shirts and short- sleeved shirts; Short- sleeved or long-sleeved t- shirts; Short-sleeved shirts; Sweat shirts; T- shirts; Tops; Wearable garments and clothing, namely, shirts	3810792	6/29/2010
				
ROLLER BONES	28	Roller Skate Wheels	3584070	3/3/2009
RAT BONES	28	Sporting goods, namely, skateboard wheels, skateboard wheel assemblies and parts and fittings for any thereof;	3633328	6/2/2009
BONES REDS	28	Ball bearings for skateboards; Nuts and bolts for skateboards; Skateboard wheels	3735248	1/5/2010
RAT BONES	25	Clothing, namely, active wear, sportswear, skate wear, and other clothing for sports, namely, T- shirts, shirts, tops, shorts, sweatshirts, belts, hats, headgear, namely, visors, baseball caps, beanies, bonnets, headbands, and caps, headwear,	3905805	01/11/2011

Each of Petitioner's Marks is valid and subsisting and constitute *prima facie* and/or conclusive evidence of Petitioner's ownership of the family of BONES marks and the exclusive right to use Petitioner's Marks on the goods and services identified in the registrations.

Furthermore, several of the above-noted registered Marks are incontestable under 15 U.S.C.

§1065. Because Petitioner's Marks are arbitrary and strong and further because Petitioner has

used the mark BONES continuously since 1977 in connection with apparel in Class 25 long before Respondent's first use in commerce of Respondent's Mark or any use that may be asserted for Respondent's Mark, Petitioner is entitled to protection of his distinctive marks.

3. Petitioner, through long use of the BONES trademark and substantial advertising and promotion has developed valuable goodwill in connection with Petitioner's Marks. Petitioner's apparel goods and sporting goods have been offered and advertised continuously to the public throughout the United States through various channels of trade, including department stores such as Nordstroms, clothing stores, surf shops, sporting good stores, skate shops, and action sports stores in conjunction with Petitioner's Marks since at least as early as June 1977. By reason of such advertising and wide distribution of Petitioner's goods and services, the public recognizes the mark BONES as solely signifying the goods and services offered by Petitioner.

4. Petitioner uses the word BONES in conjunction with clothing and apparel goods which are sold in department stores, surf shops, skateboard shops, and sporting goods stores which sell to a wide variety of customers.

5. Notwithstanding Petitioner's exclusive prior rights in and to the trademarks incorporating the term BONES, Respondent, on January 10, 2008, filed an application to register the trademark BIG BONEZ, in Class 25 for "*Clothing and Headwear*" which was subsequently modified by an examiner's amendment to "*Clothing, namely, shirts, t-shirts, tops, jerseys, vests, sweaters, caps, bandanas, shorts, sweat shirts, pants, belts, socks, swimwear, jackets, rainwear, footwear, hats, headbands, headwear, pajamas, sleepwear and undergarments.*" Said application was assigned Serial No. 77368590 and the mark was registered by the U.S. Patent and Trademark Office on September 15, 2009.

6. The mark BIG BONEZ, is confusingly similar in sound, appearance, and connotation to Petitioner's Marks.

7. Respondent's Mark has been registered for goods that are closely related to the goods of Petitioner. The use of the word BIG BONEZ is likely to be confused with the goods sold by Petitioner bearing the Petitioner's Marks.

8. Respondent's clothing goods may have been offered, if they were in fact sold at all, to the same type of consumers and through the same channels of trade and distribution as Petitioner's clothing goods. The use and continued registration of the Respondent's Mark would therefore be closely related to Petitioner's use of Petitioner's Marks on clothing and apparel. Potential purchasers of any of Respondent's clothing and apparel goods would be potential purchasers of Petitioner's clothing goods and may be sold in the same retail stores and channels of trade.

9. Petitioner's Marks are famous throughout the entire action sport and board sports industry and in other areas.

10. Respondent's Mark, so resembles Petitioner's Marks that the continued registration of Respondent's Mark and any further use, if any, by Respondent of Respondent's Mark is likely, when applied to the goods identified in Respondent's Registration, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act, all to Petitioner's damage.

11. Petitioner's Marks became famous before the filing date of Serial No. 77368590 and any date of use that may be claimed by Respondent and have strong and distinctive character qualifying them for protection under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), as amended.

12. The 850 Registration was registered on September 15, 2009 and therefore is subject to the provisions of Section 43(c) of the Lanham Act, as amended.

13. Petitioner believes that the registration of Respondent's Mark in Class 25 will cause dilution of the distinctive quality of Petitioner's Marks and seriously and substantially damage Petitioner in violation of Section 43(c) of the Lanham Act, as amended.

14. On information and belief, Respondent was not using Respondent's Mark for all of the goods identified in the Statement of Use at the time of the filing of the Statement of Use, and had never used or has discontinued, without an intent to resume, any and all use of the BIG BONEZ Mark for the goods listed in the Statement of Use.

15. On information and belief, although the Statement of Use filed by Respondent on July 14, 2009, under oath, indicated that Respondent was using the BIG BONEZ mark in commerce in connection with all the items listed, namely "*Clothing, namely, shirts, t-shirts, tops, jerseys, vests, sweaters, caps, bandanas, shorts, sweat shirts, pants, belts, socks, swimwear, jackets, rainwear, footwear, hats, headbands, headwear, pajamas, sleepwear and undergarments*" Respondent in fact was not using and had no bona fide intention at the time of filing or later to use Respondent's Mark in commerce in connection with all of the goods listed in the Statement of Use.

16. Respondent did not use and did not have a bona fide intention to use the BIG BONEZ mark in commerce for all of the goods specified in the 850 Registration when the same was registered.

17. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for all of the goods listed in Application No. 77368590 that eventually matured into the 850 Registration.

18. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for "*vests*".

19. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*sweaters*”.

20. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*bandanas*”.

21. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*shorts*”.

22. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*belts*”.

23. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*socks*”.

24. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*swimwear*”.

25. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*jackets*”.

26. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*rainwear*”.

27. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*footwear*”.

28. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*headbands*”.

29. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*pajamas*”.

30. On information and belief, Respondent has never used the BIG BONEZ mark or offered for sale goods under the BIG BONEZ mark for “*sleepwear*”.

31. Upon information and belief, Respondent was not using the mark BIG BONEZ on or in connection with all of the goods listed in 850 Registration when Respondent filed the Statement of Use, and upon information and belief, Respondent is not currently using the mark BIG BONEZ in connection with any of the items listed in the 850 Registration. Therefore, upon information and belief, when Respondent submitted the Statement of Use indicating that Respondent first used the mark BIG BONEZ for all those items on May 1, 2008, such information was false.

32. Upon information and belief, the Statement of Use and the declaration alleging use of the BIG BONEZ mark was made in bad faith and in an attempt to perpetrate a fraud upon the USPTO because Respondent knew or acted in a reckless disregard of the truth that it was not using the mark BIG BONEZ in connection with all of the goods listed at the time of the filing of the Statement of Use.

33. Upon information and belief, while reasonably relying on the truth of such materially false statement, the USPTO approved Serial No. 77368590 for registration, issuing the 850 Registration.

34. Upon information and belief, the conduct of Respondent constitutes fraud on the USPTO and therefore the 850 Registration should be cancelled.

35. Trademark Act Section 1(b), 15 U.S.C. §1051(b), allows registration of trademarks “used in commerce” and requires that an applicant make a verified statement that the mark is in use in commerce.

36. Section 45 of the Act, 15 U.S.C. § 1127, defines the term “use in commerce” and states: “The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce— (1) on goods when — (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce.”

37. Upon information and belief Respondent did not use the mark BIG BONEZ in commerce on or in association with all the goods identified in the 850 Registration as of the filing date of either the Statement of Use or the May 1, 2008 alleged date of first use anywhere or the June 1, 2008 date of first use in commerce, as required under Trademark Act Sections 1(a), 1(d), and 45, 15 U.S.C. §§1051(a), 1051(d), and 1127.

38. Accordingly, Application Serial No. 77368590 and the resulting 850 Registration, are void *ab initio*, and the 850 Registration should be cancelled.

39. Upon information and belief, Respondent has ceased using the mark BIG BONEZ in association with all of the goods identified in the 850 Registration.

40. Upon information and belief, Respondent has never used or has discontinued, without an intent to resume, any and all use of the mark BIG BONEZ in association with the goods identified in the 850 Registration with intent not to resume any such use in the future.

41. On information and belief, Respondent has abandoned use of the BIG BONEZ Mark, and therefore is no longer entitled to maintain his registration.

42. Upon information and belief, there never has been a legal entity registered as “BIG BONEZ, INC.”, the entity identified on the tag associated with the specimen submitted with the Statement of Use.

43. Respondent has, upon information and belief, ceased all commercial use of the mark BIG BONEZ in association with the goods identified in the 850 Registration with intent not to resume any such use in the future.

44. Respondent’s non-use of the BIG BONEZ Mark for more than three (3) consecutive years as a trademark is prima facie evidence of abandonment pursuant to Lanham Act 15 U.S.C. § 1127.

45. Although Respondent has abandoned its registered mark, Petitioner has been and will continue to be damaged by the existence of 850 Registration in that unless the registration is cancelled, Petitioner’s mark will be damaged by the continued existence of the 850 Registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

46. Respondent’s Mark was unregistrable pursuant to Section 1(b) of the United States Trademark Act, as amended, 15 U.S.C. §1052(b) and should be cancelled.

WHEREFORE, Petitioner believes he will be damaged by said registration and requests that the 850 Registration for the mark BIG BONEZ be cancelled on the grounds set forth herein and that this Cancellation be sustained.

This Petition for Cancellation is submitted with the required filing fee of \$300.

Respectfully submitted,

Dated: September 14, 2014

By:


Kurt Koenig
920 Garden St., Suite A
Santa Barbara, CA 93101
Tel: 805-965-4400
Attorney for Petitioner

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being transmitted by electronic mail to the United States Patent and Trademark Office via ESTTA with the required fees on the date identified below.

Dated: September 14, 2014



Kurt Koenig

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing "PETITION FOR CANCELLATION" was served on September 14, 2014 by first-class mail, postage prepaid, to Respondent addressed as follows:

Michael M. Woldman
64 Weaver Road
Rockford, IL 61114

Dated: September 14, 2014



Kurt Koenig
